

## REMARKS

Claims 13-17 and 19-21 are pending in this application.

Claims 23, 24, 26, and 27, withdrawn from consideration, have been currently cancelled.

No claims have been amended.

Applicants note with appreciation that the product claims, claims 13 and 14, drawn to compounds of formula (2), were found to be allowable.

Moreover, since the product claims were found to be allowable, the withdrawn claims to the process used to make compounds of formula (2) (claims 15, 16 and 17) that depend from or otherwise include all the limitations of the allowable product claim can be rejoined in accordance with the provisions of MPEP 821.04.

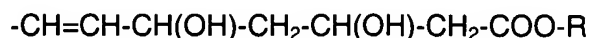
Since the withdrawn process claims to make compounds of formula (2), claims 15 and 16 and 17, all depend from or otherwise include all the limitations of the allowable product claim 13, rejoinder is hereby requested.

Claims 19-21 are rejected as obvious over Kathawala (U.S. Patent No. 4,739,073) and further in view of Jerry March, Advanced Organic Chemistry, 3<sup>rd</sup> ed., 1985, pp 809, 431, and 432. Applicants respectfully traverse this rejection for the reasons that follow.

In the paragraph bridging pages 10 and 11 the examiner discusses generic formula (I) of U.S. Patent No. 4,739,073, concluding "... Kathawala teaches the identical compound of claims 19-21 of the Instant Application" therein. Applicants respectfully submit that this conclusion is clearly erroneous.

Instant claims 19-21 relate to intermediates of formula (3).

Applicants' formulae (1) (= end product) and (3) (= intermediate) differ in their acyclic chain lengths, which are:



in present formula (1), which is congruent with "X-Z" in formula I of US '079, and

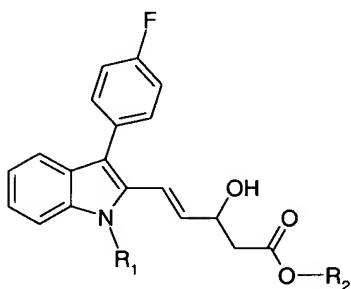


in present formula (3).

Thus, there is a clear line of distinction given between the compounds taught in generic formula (I) of US' 073 and those of the present claims.

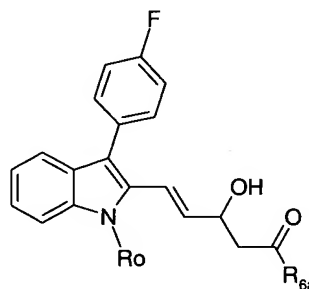
This difference appears to be acknowledged by the examiner on page 11, lines 10-12, of the Office Action where the difference between the invention and prior art is stated to be that the instant invention has a carboxylic acid or ester where the prior art has a ketone substituent. This was depicted as follows:

Instant Invention



Wherein R<sub>1</sub> is C<sub>1</sub>-C<sub>6</sub>alkyl and R<sub>2</sub> is hydrogen or a hydrocarbon radical

Prior Art (US 4,739,073)



Wherein R<sub>0</sub> is C<sub>1</sub>-<sub>6</sub>alkyl and R<sub>6a</sub> is methyl.

Clearly these compounds are different. Moreover, analogous prior art ketone compounds would not suggest compounds having a carboxylic acid or ester substituent. Said compounds are neither isomers nor homologues of the corresponding ketones. One skilled in the art would know that said compounds would have quite different physical and chemical properties, and probably quite different biological properties as well.

The examiner relies on the secondary reference, Advanced Organic Chemistry by Jerry March, to show that one of ordinary skill in the art would have been able to convert the compounds shown in Kathawala to compounds of claims 19-21 via standard organic chemical reactions as described in the March textbook. However, no motivation is seen for the skilled person to convert the intermediate ketone of US '073 into an acid or ester according to the present claims.

Even if standard chemical reactions such as those shown in the cited March textbook were able to effect this conversion without affecting the neighboring double bond and the stereochemistry, neither of which is clear from March, US' 073 teaches (1) reaction of the above ketone intermediate with a carboxylic acid derivative to protect the OH group and (2) conversion with a strong base and an acetic ester to form the desired chain-extended product. See the reaction scheme showing this conversion: formula (X) -> formula (XIII) in column 10 of US' 073.

There is nothing in U.S. Patent No. 4,739,073 that could give any suggestion to the skilled artisan to deviate from the disclosed reaction schemes and, instead of subjecting the ketone obtained directly to the chain extension reaction, to degrade it to a 1,3-diol and to try to selectively convert the diol into an acid or ester while hopefully preserving the presence and stereochemistry of an allylic OH group.

How can it be obvious, from a reference, to ignore its teachings and go off in a totally different direction?

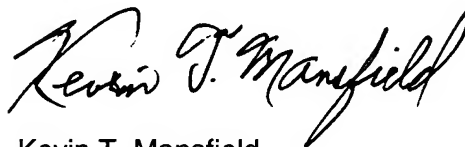
Applicants aver that the motivation to prepare the compounds of claims 19-21 stems from the disclosure in this application that they are valuable intermediates in an alternate synthesis of pharmaceutical end products. But hindsight is a clearly inadequate basis for a rejection under 35 U.S.C. § 103(a).

Reconsideration and withdrawal of the rejection of claims 19-21 as obvious over Kathawala and further in view of March, Advanced Organic Chemistry, is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 13-17 and 19-21 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, reading "Kevin T. Mansfield". The signature is written in a cursive, flowing style.

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Enclosure: Petition for Extension of Time